

REMARKS

In the Office Action, claims 1-11, 13-15, and 17-27 were rejected. By the present Response, Applicants submit declarations pursuant to 37 C.F.R. § 1.131 to remove Siegel, U.S. Patent No. 7,149,353 (hereinafter “Siegel”) as prior art. Additionally, claims 25-27 are amended. Upon entry of these amendments, claims 1-11, 13-15, and 17-27 will remain pending in the present patent application. In view of the following remarks and appended evidence, Applicants respectfully request reconsideration and allowance of all pending claims.

Preliminary Remarks

As a preliminary matter, it is noted that in response to the previous Office Action mailed June 20, 2008, Applicants submitted Rule 131 declarations from Yaseen Samara Vijaykalyan Yeluri, co-inventors of record for the present application, and of the undersigned, Patrick Yoder, the attorney who prepared and filed the present application. Along with these previously submitted declarations, Applicants provided copies of e-mail correspondence as exhibits for demonstrating conception of the invention *prior* to the filing date of Siegel. Based on these previously submitted declarations and evidence, it was believed that Applicants had demonstrated conception of the invention from prior to the filing of Siegel, coupled with diligence up to the filing of the present application.

In the present Office Action, the Examiner asserted that the previously submitted declarations and evidence were insufficient to show conception and diligence. While Applicants do not necessarily agree with the Examiner’s position, Applicants have submitted additional declarations and evidence by the present Response. As will be discussed further below, it is believed that the presently submitted declarations and additional evidence demonstrate that the invention disclosed and claimed in the present application was conceived of *prior* to the filing of Siegel, and that diligence was exercised from *prior* to the filing of Siegel *through* the filing of the instant application.

Rejections Under 35 U.S.C. § 103

In the Final Office Action, claims 1-7, 10, 13, 14, 19, 20, 22, 23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Ittner, U.S. Patent No. 5,664,027 (hereinafter “Ittner”). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Ittner, as applied to claim 1, and further in view of Willis et al., U.S. Patent No. 5,568,571 (hereinafter “Willis”). Claims 8, 11, 15, 17, 18, 21, 24, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Jordan, U.S. Patent No. 6,823,203 (hereinafter “Jordan”), and Ittner. Applicants respectfully traverse these rejections. In particular, Applicants submit that the following remarks and the appended evidence are sufficient to demonstrate prior invention with regard to Siegel, which is the primary reference relied upon by the Examiner in rejecting all of the pending claims.

Prior Invention with Regard to Siegel

To establish prior invention, an applicant must present a “showing of facts [that] shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. §1.131(b). Applicants respectfully submit that such a showing is made by way of the appended declarations and the accompanying exhibits.

On its face, Siegel has an actual filing date of September 23, 2003. Accordingly, the earliest possible date upon which the Siegel may be relied for a rejection is September 23, 2003. Applicants respectfully submit that the accompanying Rule 131 declarations establish conception of the subject matter disclosed and claimed in the present invention prior to September 23, 2003, coupled with diligence up to the time of filing of the instant application on November 26, 2003. Specifically, the accompanying declarations include the declarations under 37 C.F.R. § 1.131 of Yaseen Samara (hereinafter the “Samara

Declaration") and of the undersigned, Patrick S. Yoder, as the attorney who prepared and filed the present application (hereinafter the "Yoder Declaration").

As indicated in the Samara Declaration, the subject matter disclosed and claimed in the above-referenced patent application was conceived of prior to September 23, 2003. This conception is evidenced by an invention disclosure document that was prepared by one or more of the co-inventors of record and submitted in the ordinary course of business to the intellectual property department of General Electric Company ("GE"), the assignee of the present application. *See* Samara Declaration, paragraph 4. A redacted copy of this invention disclosure document is attached to the Samara Declaration as Exhibit A. As indicated on page 1 of Exhibit A of the Samara Declaration, the invention disclosure document was assigned the docketing number "133276" by GE (hereinafter the "133276 disclosure document").

Prior to September 23, 2003, GE engaged the law firm of Fletcher Yoder, where Mr. Yoder was then and is presently employed, for the preparation and filing of the above-identified application. *See* Yoder Declaration, paragraph 4. This engagement is evidenced by an engagement letter sent to Mr. Yoder from GE's intellectual property department, a redacted copy of which is attached to the Yoder Declaration as Exhibit A. As shown by Exhibit A of the Yoder Declaration, several new patent disclosures were assigned to Mr. Yoder for preparation, including the 133276 disclosure document. *See id.* at Exhibit A, page 3. Upon engagement of Fletcher Yoder, the above-identified application was duly docketed for preparation in the ordinary course of business. *See id.* at paragraph 6. Particularly, upon intake, a matter relating to the preparation of a patent application based upon the 133276 disclosure document was opened and assigned the reference number "GEMS:0234" for Fletcher Yoder's internal docketing system in addition to retaining GE's docketing number 133276. *See id.* Additionally, on or around the time that the engagement letter was received, Mr. Yoder was also forwarded a copy of the 133276 disclosure document for review. *See id.* at paragraph 5; Exhibit B.

Prior to September 23, 2003 and after receiving the 133276 disclosure document, Mr. Yoder contacted Prakash Mathew and Mr. Samara via e-mail to schedule a telephone conference to discuss the 133276 disclosure document. *See* Yoder Declaration, paragraph 6; *see also* Samara Declaration, paragraph 5. A redacted copy of this e-mail communication is provided as Exhibit B of the Samara Declaration and as Exhibit C of the Yoder Declaration. As shown in this e-mail communication, the subject of the telephone conference related to a discussion of information contained in the 133276 disclosure document and another disclosure referred to by the number 133277 (hereinafter the “133277 disclosure document”). As further indicated by the Yoder Declaration, this telephone conference was scheduled and conducted between Mr. Yoder and at least Mr. Mathew prior to September 23, 2003. *See* Yoder Declaration, paragraph 5.

Subsequent to the above-reference telephone conference, Mr. Yoder received an e-mail communication from Mr. Mathew on August 14, 2003, in which Mr. Mathew inquired as to the status of patent application drafts relating to the 133276 disclosure document and the 133277 disclosure document. *See* Samara Declaration, paragraph 6; *see also* Yoder Declaration, paragraph 7. In response to the inquiry, Mr. Yoder indicated on August 19, 2003, that drafts for the 133276 and 133277 disclosure documents had not yet been completed, but that he would complete the drafts as soon as possible. *See* Samara Declaration, paragraph 8; *see also* Yoder Declaration, paragraph 9. A copy of this e-mail correspondence is provided as Exhibit D of the Yoder Declaration and as Exhibit C of the Samara Declaration.

Based on the foregoing facts and evidence, including the 133276 disclosure document, the engagement letter to Mr. Yoder from GE, and the above-referenced telephone conference, it is respectfully submitted that Applicants clearly conceived of the invention ultimately disclosed and claimed in the present patent application and were in

fact in possession of the invention at least as early as August 14, 2003. *See Samara Declaration*, paragraph 7. Accordingly, Applicants submit that the subject matter disclosed and claimed in the above-referenced application was *clearly* conceived prior to the filing of Siegel on September 23, 2003. Further, it should be noted that the conception of the present invention occurred in the United States. *See id.* at paragraph 12.

Applicants further submit that diligence was exercised by the inventors and by Mr. Yoder from prior to September 23, 2003 and up through the filing of the present application on November 26, 2003. As discussed above, *prior* to September 23, 2003, the subject matter set forth in the 133276 disclosure document was submitted to GE's intellectual property department and received by Fletcher Yoder for preparation of the present patent application. On November 15, 2003, Mr. Yoder sent an e-mail communication containing a first draft of the above-identified application to Messrs. Mathew and Samara for review. *See* Yoder Declaration, paragraph 10; *see also* Samara Declaration, paragraph 9. A set of formal papers, including assignment and declaration forms, were also sent in conjunction with the first draft. *See id.* A redacted copy of this correspondence is provided as Exhibit E of the Yoder Declaration and as Exhibit D of the Samara Declaration. As indicated in this correspondence, Mr. Yoder requested that the inventors review, provide feedback, and return the executed formal papers by November 24, 2003. *See* Yoder Declaration, paragraph 10; Exhibit E; *see also* Samara Declaration, paragraph 9; Exhibit D. Upon receiving the executed formal papers from each of the inventors, Mr. Yoder filed the above-identified application on November 26, 2003, thereby resulting in constructive reduction to practice of the invention disclosed and claimed in the present patent application. *See* Yoder Declaration, paragraph 11.

Under the present set of facts, the relevant critical period runs from just prior to September 23, 2003 (the filing date of Siegel) to the filing of the present application on November 26, 2003. In the Office Action, the Examiner stated that periods of inactivity

occurring during the critical period must be accounted for by “acceptable excuses.” Office Action, page 3. In addressing this point, it is Applicants’ understanding that the Federal Circuit recognizes situations in which a drafting attorney has a reasonable backlog of cases to prepare as being an acceptable excuse for delays in preparing and filing a particular patent application. For instance, as reiterated under Section 2138.06 of M.P.E.P., *reasonable diligence* is all that is required of the attorney, and is established if attorney worked reasonably hard on a particular application during the continuous critical period. *See Bey v. Kollonitsch*, 866 F.2d 1024, 231 U.S.P.Q. 967 (Fed. Cir. 1986). If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. *See id.* (Emphasis added.)

With these points in mind and as stated in the Yoder Declaration, the present application was duly docketed by Fletcher Yoder prior to September 23, 2003 for preparation in the ordinary course of business and was in fact prepared in the ordinary course of business, as evidenced by the filing of the present application on November 26, 2003. The Yoder Declaration further sets forth that Mr. Yoder had a backlog of cases and related patent prosecution work for GE and other clients of Fletcher Yoder during this critical period that prevented him from completing the present application sooner. *See* Yoder Declaration, paragraph 12. Thus, with the above-discussed case law in mind, Applicants respectfully submit that delays in drafting the patent application between the beginning of the critical period (September 23, 2003) and the filing the present application (November 26, 2003) were attributable to Mr. Yoder’s backlog of case work and, thus, constitutes a reasonable and acceptable excuse in evaluating the issue of diligence. Indeed, the Board of Patent Appeals and Interferences has noted that *reasonable diligence* does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved.” *See Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. App. & Inter. 1974).

In view of above discussion and the facts provided by the newly submitted declarations and appended evidence, Applicants respectfully submit that a showing has been made that the invention disclosed and claimed in the present patent application was conceived *prior* to September 23, 2003, and that diligent efforts were made from *prior* to September 23, 2003 to the time the present application was filed (resulting in constructive reduction to practice). Accordingly, Applicants submit that prior invention has been demonstrated with respect to Siegel and, therefore, respectfully request that the Examiner remove Siegel as prior art with regard to the present application.

Deficiencies of the Rejection

As noted above, the Examiner rejected all of the pending claims under Section 103 in the present Office Action relying upon Siegel as a primary reference. Applicants further note that in setting forth these Section 103 rejections, the Examiner admitted that Siegel fails to disclose several features recited by the pending claims, and thus further relied on one or more of Ittner, Willis, or Jordan as secondary references to cure the deficiencies of Siegel. However, in view of the above discussion, Siegel cannot be considered as prior art with regard to the present application and, therefore, cannot be applied in the instant Section 103 rejections. Therefore, absent the availability of Siegel as prior art, Applicant submit that Ittner, Willis, or Jordan references, taken alone or in combination, do not anticipate or render obvious the pending claims. As such, Applicants respectfully request that the Examiner remove Siegel from consideration, withdraw the outstanding Section 103 rejections, and allow the pending claims.

Claim Rejections Under 35 U.S.C. § 101

In the Office Action, the Examiner maintained the rejection claims 25-27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated that “[c]laims 25-27 recite an ‘image ... stored on computer-readable medium,’ which does not impart *functionality* to a computer or computing device, and is thus considered nonfunctional descriptive material.” *See* Office Action, page 4.

(Emphasis in original.) Although Applicants do not necessarily agree that the Examiner's reasoning in rejecting claims 25-27 is proper, rather than belabor this point, Applicants have chosen to amend each of claims 25, 26, and 27 to recite a tangible computer readable medium having stored thereon an image generated by the method recited in claims 1, 10, and 15, respectively. Because computer readable mediums have widely been recognized as being statutory under Section 101, Applicants respectfully request that the Examiner withdraw the present rejection and allow claims 25-27.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 31, 2009

/Patrick S. Yoder/

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Attachments:

Rule 131 Declaration of Yaseen Samara (w/ exhibits)
Rule 131 Declaration of Vijaykalyan Yeluri (w/ exhibits)
Rule 131 Declaration of Patrick S. Yoder (w/ exhibits)